

WANG ET AL. - 10/089,169
Client/Matter: 082137-0280714

REMARKS

Reconsideration and allowance of the subject application in view of the above amendments and following remarks is respectfully requested.

Preliminary Remarks

Claims 25-33 are pending in this application. Claims 1-24 have been cancelled. New claims 25-33 substantively represent original claims 1-9, but have been rewritten to correct numerous typographical errors found in the original claims. No new matter is introduced by any of the claim amendments.

Rejection under 35 U.S.C. § 112

In paragraph 2 of the official action, the examiner rejected claim 1 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner asserted that the chemical structure as claimed on page 64, last paragraph of claim 1 wherein "R₃ is a covalent bond replacing the hydrogen group of R₁ when R₁ is alcohol or hydroxyl" is very confusing. The examiner further asserted that it is unclear what is the structure and what constitute the linkage between the R₃ attached carbon and the oxygen attached to R₂.

In the second section of paragraph 2 of the official action, the examiner also rejected claim 1 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The examiner asserted that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The examiner notes that the claim requires that R₃ is a "covalent bond" therefore must be of a structure which was not included in the Office Action. No description or enabling support can be found in the specification as to how to make or use a compound of the above chemical structure.

Applicants respectfully disagree.

The language "R₃ is a covalent bond replacing the hydrogen in a hydroxyl group of R₂ when R₂ is alcohol or hydroxyl" merely indicates that there is a direct bond (covalent bond) between the C-4 carbon atom of the piperizine ring and the group R₂. Thus, when R₃ is a covalent bond as defined, the structure is a fused ring structure, including an O atom from R₂.

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Accordingly, the language of claims 1-9 is not indefinite and one of ordinary skill in the art would be able, using the procedures described in the specification and the knowledge of the practitioner, to prepare the claimed compounds.

Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §§ 102(a) or (b)

Claims 1 and 2 are considered to be anticipated by any one of U.S. 2,489,669, U.S. 3,408,445, U.S. 3,965,104, U.S. 3,887,568, U.S. 3,591,593, Draper, CA 74:68906; Casy et al, CA 130:351978, Gardner et al, CA 52:24599 and Geigy et al, CA 63:3273.

Applicants respectfully disagree and request withdrawal of this rejection.

None of the cited references disclose the compounds having formula (I) and the specific stereoconfiguration as shown and claimed. Only racemic mixtures but not the particular stereoconfiguration are described.

Since the stereoconfiguration is part of the claimed subject matter and is not shown in the art, the rejections for lack of novelty should be withdrawn.

Claims 1 and 3 are considered to be anticipated by Steiner, U.S. 5,512,584.

Applicants respectfully disagree and request reconsideration and withdrawal of this rejection.

Steiner does not disclose compounds having the formula (I) and the specific stereoconfiguration as shown and claimed. Only racemic mixtures but not the particular stereoconfiguration are described.

Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102(f)

Claims 1-9 are rejected in view of CA 133:66179, CA 133:171745, and CA 133:339052 (sic 135:339052?), as evidence that the subject matter was invented by other than the present authors.

Applicants respectfully disagree and request withdrawal of this rejection.

CA 133:66179 is an abstract of an article naming Kuleshova, L.N. and Khrustaleva, V. N., as co-authors.

CA 133: 171745 is an abstract of an article naming Upton, Christopher, Osborne, Richard H, and Jaffar, Mohammad, as co-authors.

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CA 135:339052, published in 2001, is an abstract of an article authored by S. Wang, S. Sakamuri, I.J. Enyedy, A.P. Kozikowski, W.A. Zaman, and K.M. Johnson.

The first two of these articles have no overlapping authorship with the present inventors and do not provide any evidence, whatsoever, that the present applicants did not independently (and earlier) conceive of and reduce to practice the subject matter now claimed.

The third Abstract, published some two years following the earliest effective date and more than one year than the immediately preceding priority date, coming out of the same research group with which the present inventors are associated, also does not provide any evidence that the present inventors were not the true and original inventors of the claimed subject matter.

There is no evidence that the inventors listed on this application did not invent the claimed subject matter. If the Examiner believes that any of these references anticipate the claimed invention, then Applicants respectfully request that the Examiner frame these references in a 35 U.S.C. § 102(a) or § 102(b) rejection; 35 U.S.C. § 102(f) is not the proper section to cite when making this rejection.

Accordingly, withdrawal of the rejection under section 102(f) is respectfully requested.

Rejection under 35 U.S.C. 103(a)

Claims 1-9 are rejected as allegedly obvious over Steiner et al, US 5,512,584, in view of Casy CA 130, Yanai, CA 129 and Foy CA 118.

Applicants respectfully disagree and request reconsideration and withdrawal of this ground for rejection.

As noted above, Steiner does not disclose the particular stereoconfiguration of the disclosed compounds and this deficiency is not obviated by the secondary references.

Accordingly, the combined disclosures of the cited references, even if properly combined, would not have suggested the compounds and methods according to the present claims.

CONCLUSION

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The pending claims comply with all requirements for patentability and favorable action consistent with the foregoing is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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